Supreme Court, U.S.
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No. 01-186

IN THE
Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
AND MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

REPLY TO BRIEF IN OPPOSITION

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September 10, 2001

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Respondents fail to come to grips with this Court's teaching in *New York Times Co. v. Tasini*, 121 S. Ct. 2381 (2001), or the implications of the decision below for the creation of archives of collective works. Respondents do not deny that they authorized the publication of their freelance contributions in *National Geographic* magazine, or that the Complete National Geographic (CNG) reproduces those contributions intact in their original context. Rather, their argument (and the decision below) is based on the proposition that a publisher necessarily infringes the copyrights of its freelance contributors by creating an archive of its own collective works *even if* each freelance contribution remains in the precise context of the original collective work. *See* Opp. 8. That is so, respondents assert, because the Copyright Act contains an "express prohibition" on the reproduction of freelance contributions in a "new collective work." *Id.* Because a collection of collective works like the CNG is itself a collective work, they argue, it violates "the prohibition against new collective works." *Id.*

The problem with that argument is that no such "prohibition" exists. As petitioners have explained, the statute expressly authorizes publishers to reproduce freelance contributions to a collective work "as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series." 17 U.S.C. § 201(c). Nowhere does the statute state, suggest, or even hint that this privilege vanishes if the publisher creates a "new collective work." To the contrary, the latter two categories *invariably* involve the creation of a new collective work, and the very paragraph of the legislative history on which respondents rely specifically authorizes the inclusion of a freelance contribution in a new collective work—a later edition of an encyclopedia or magazine. *See* H.R. Rep. No. 94-1476, at 122-23 (1976).

Thus, as this Court explained in *Tasini*, the key issue under Section 201(c) is whether an individual freelance contribution is "presented to, and perceptible by" the end user in its "original context" as "part of the collective work to which the author contributed." 121 S. Ct. at 2390-92. The three databases at issue in *Tasini* fell outside the statutory reproduction privilege because in each database "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented," *id.* at 2384—*not* because each database was itself a "new collective work."

As the *Tasini* Court explained, the statute thus strikes a fundamental balance between the freelancer's copyright in an individual contribution and the publisher's copyright in the collective work. *See id.* at 2389. "If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand," but by the same token allows the publisher to benefit from the demand for the collective work. *Id.* The publisher can thus reproduce individual freelance contributions as part of the original collective work, but cannot *remove* such contributions from the original collective work and claim that they remain part of "that particular collective work," or "any revision of that collective work." 17 U.S.C. § 201(c). "It would scarcely preserve the author's copyright in a contribution as contemplated by Congress, if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author's contribution in isolation or within new collective works." *Tasini*, 121 S. Ct. at 2389 (internal quotation omitted).

Respondents seize on that single reference to "new collective works" to turn the overall statutory balance upside down. According to respondents, the *Tasini* Court thereby "said that the context requirement of Section 201(c) can be violated in *two* ways": *either* [1] "by lifting a contribution out of the context in which it first appeared to an end user, and

placing it in isolation," *or* [2] by creating "a new collective work," *even if the contribution remains in the original collective work.* Opp. 7 (emphasis added). But the *Tasini* Court said no such thing. To the contrary, the very passage on which respondents rely specifically reaffirms the balance between the freelancer's copyright in the individual contribution and the publisher's copyright in the collective work. *See* 121 S. Ct. at 2389. To say that a publisher cannot remove an individual contribution from a collective work and place it in a new collective work is not to say that a publisher cannot place the original collective work *in its entirety* in a new, and larger, collective work. The issue, as the *Tasini* Court explained, is whether a user perceives the individual contributions in the context of the original collective work, not whether a "new" collective work has been created.

Respondents thus miss the point by arguing that "Petitioners . . . attempt to create an *exception* to the prohibition where the author's contribution, and the original collective work in which it first appeared, are incorporated in a new collective work." Opp. 8 (emphasis added); *see also id.* ("[T]here is no *exception* to the express prohibition involving new collective works merely because an author's contribution remains in the 'context' in which it was originally published.") (emphasis added). Petitioners have no need for any such "exception" because the statute contains no such "prohibition" in the first place. Indeed, if the creation of a new collective work *per se* defeated the privilege, then the *Tasini* Court's discussion of context was completely unnecessary, because the "crucial fact" in *Tasini* would have been the creation of "new collective works," not the context in which the freelance contributions were presented.

The *Tasini* Court only underscored this point in its discussion of microfilm and microfiche. As the Court explained, microform "contains multiple editions" of a particular newspaper or magazine. 121 S. Ct. at 2391. Thus, under respondents' view, reproduction in microform should

infringe a freelancer's copyright because it is a "new collective work." But the *Tasini* Court went out of its way to note that microform "perceptibly reproduce[s] articles as part of the collective work to which the author contributed or as part of any 'revision' thereof" precisely because it presents the articles *in their original context*. *Id.* at 2391-92. If, as respondents contend, the creation of a "new collective work" defeats the 201(c) privilege wholly apart from the "context" in which a freelance contribution is reproduced, the *Tasini* Court's discussion of microform makes no sense.

Respondents' answer on this point is twofold. *First*, they insist that, "[c]ompletely contrary to the Petitioners' assertion, the *Tasini* Court did not hold that microform (microfilm or microfiche) reproduction qualifies for the Section 201(c) privilege." Opp. 9. But that is no answer at all. Obviously, the Court's discussion of microform was not a "holding," since the *Tasini* case did not involve microform. That discussion, however, illuminates the *reasoning* underlying the Court's holding, and that reasoning is squarely inconsistent with respondents' position and the decision below. *Second*, respondents assert that "the microform described by the Court would present the end user with the *original context* of 'that particular collective work' referenced in Section 201(c)." *Id.* (emphasis added). But again, that is no answer at all, because respondents' entire argument is premised on the notion that Section 201(c) prohibits the creation of "new collective works" *regardless* of the "context" in which contributions are presented. Because the CNG, like microform, contains an exact, image-based reproduction of every page of every issue of *National Geographic* magazine, the original context is preserved in a new medium, and the reproduction falls within the Section 201(c) privilege.

Respondents, however, deny that the decision below violates the bedrock principle of media neutrality. According to respondents, "[t]he Eleventh Circuit *did not hold* that reproduction of the Greenberg photographs in a different

electronic medium would be inherently impermissible." Opp. 11 (emphasis in original). But that is precisely the effect of the Eleventh Circuit's twin holdings that (1) the existence of copyrightable computer software in a CD-ROM leads to the creation of a "new collective work," and (2) the creation of a "new collective work" automatically defeats the Section 201(c) privilege. App. 9a-11a & n.12. Under that approach, a publisher can *never* reproduce its collective works on CD-ROM without infringing its freelancers' copyrights, because (as respondents themselves acknowledge) "[e]very CD-ROM does indeed require at least minimal software to permit page-by-page access to printed matter reproduced in a digital format." Opp. 11.

Respondents attempt to downplay the implications of this "draconian outcome," *id.*, by asserting that "the CNG goes far beyond what is *minimally necessary* in digital technology," *id.* at 11-12 (emphasis added). But the Eleventh Circuit adopted no such "minimal necessity" test, and any such test is utterly foreign to the statute and unworkable in practice. To the contrary, the Eleventh Circuit expressly attempted to distinguish CD-ROM from microform on the ground that CD-ROM contains "computer programs [that] are themselves the subject matter of copyright." App. 11a n.12. Accordingly, respondents do not so much defend as flee from the decision below by arguing that "a publisher wanting to reproduce an author's work in a digital format can satisfy Section 201(c) by utilizing a software program that simply stores the work and allows page-by-page display." Opp. 18. The Eleventh Circuit created no such safe harbor for *some* software, and in fact such a safe harbor conflicts with the court's reliance on the inherently copyrightable nature of *all* computer software.

Respondents' assertion that "the CNG contains other materials and other capabilities that even more forcefully support the Eleventh Circuit's holding of infringement," *id.* at 1, 12, thus misses the point. The Eleventh Circuit expressly acknowledged that "[e]very cover, article, advertisement, and

photograph appears [in the CNG] as it did in the original paper copy of the Magazine," and thus "[w]hat the user of the CNG sees on his computer screen . . . is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text." App. 4a. Under *Tasini*, that is the beginning and the end of this case. The fact that CNG provides additional benefits—like the ability to conduct electronic searches—does not negate the fact that it provides exact, image-based reproductions of past issues of *National Geographic* magazine, and thus presents all freelance contributions in their original context.[1] If, as respondents and the Eleventh Circuit suggest, the benefits provided by a new medium like CD-ROM defeat the Section 201(c) privilege, then the medium-neutrality principle is essentially a dead letter, because the whole point of reproducing collective works in new media is to take advantage of the benefits of those media.

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[1] Respondents' description of the technical aspects of the CNG is not only legally irrelevant but factually misleading. Among other things, respondents challenge "the Eleventh Circuit's observation that 'the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.'" Opp. 2 n.1 (quoting App. 4a). That challenge is inexplicable, because respondents themselves concede that "[t]he product's program does *not* provide that means." *Id.* at 2 (emphasis added). Rather, they assert (with no record support) that "the universal file format codes utilized in the product provide an easy means for an end user to open, edit and copy particular pages for manipulation." *Id.* But the theoretical possibility that a user could manipulate file format codes to remove an individual article from the CNG does not render petitioners liable for copyright infringement any more than does the possibility that a user could remove an individual article from the print version of the magazine with a pair of scissors and then copy or scan the image. Similarly, respondents' assertion that the CNG allows "[a]rticle-by-article inspection," *id.* at 2, 12, is misleading at best, because the CNG does not disaggregate articles from the original collective work; the user can engage in "article-by-article inspection" only by moving through the entire original issue, just as with a print version or microform. And the suggestion that the CNG includes "[a]dvanced search capability," *id.* at 2, 12, is similarly misleading, because the CNG does not allow the user to search the text of articles, but limits the search to an electronic version of the traditional print index.

Respondents also try to downplay the radical nature of the decision below by insisting that publishers can reproduce their own collective works in CD-ROM format by simply obtaining licenses from their freelance contributors. *See* Opp. 18-19. Respondents thus echo the Eleventh Circuit's casual suggestion that the district court should "consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work." App. 16a-17a. As petitioners have explained, however, it would be impossible as a practical matter to track down each one of the thousands of freelancers from around the world who have contributed to *National Geographic* over most of the last century to negotiate a retroactive license fee. Even suspending disbelief and assuming *arguendo* that National Geographic were able to track down each and every such freelancer, any single one could destroy the integrity of the entire project by simply refusing permission. Indeed, given that the alleged infringement has *already* taken place, petitioners would have essentially no bargaining power, and a freelancer would have no incentive to agree to a reasonable license fee. And the court in this case would have no power over any freelancers other than respondents, so that even if the court could impose a mandatory license fee here, it could not impose such a fee on other freelancers.

It is thus not "speculation," Opp. 18, but reality to acknowledge that the issue in this case is the ability of publishers to create electronic archives of their own collective works for the education and entertainment of future generations. The signal importance of that question warrants this Court's review. If CD-ROM archives of collective works are to vanish from the market, it should be because the Supreme Court of the United States has duly concluded that Congress has decreed that result, not because one panel of one court of appeals has interpreted one passage in the legislative history to prohibit the reproduction of anything that can be deemed a "new collective work." Nor does this Court have the luxury of allowing this issue to percolate among the lower

courts before granting review. Because CD-ROMs are distributed nationally, no publisher can take the risk of continuing to market a product that the Eleventh Circuit would deem infringing.

As explained by one group of petitioners' *amici* (who supported the *freelancers* in *Tasini* in light of the very different products at issue there), the ruling below threatens substantial harm to the public interest because "no collective work reproduced or distributed via CD-ROM, online technology, or other new technology requiring additional software to facilitate viewing or searching could, as a practical matter, ever qualify for the Section 201(c) privilege." Br. of *Amici Curiae* American Library Association *et al.* 13. As petitioners' other *amici* explain, that result is not only inconsistent with Section 201(c), but also "upsets the Constitutional balance between providing appropriate incentives to authors and maintaining public access to works by those authors." Br. of *Amici Curiae* Magazine Publishers of America *et al.* 16. Accordingly, this Court should review the Eleventh Circuit's conclusion that an exact, image-based reproduction of a collective work violates the copyrights of freelance contributors to that collective work.[2]

This Court should also review the Eleventh Circuit's accusation that National Geographic committed "fraud" on the Copyright Office when applying for a copyright registration. Respondents do not, because they cannot, defend that

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[2] Respondents err by asserting that petitioners have "waived any challenge" to the Eleventh Circuit's distinct conclusion that the use of the January 1962 cover in the CNG's brief introductory montage infringed their copyrights. Opp. 22. According to respondents, petitioners waived that point because they "did not identify that holding of infringement with the other 'Questions Presented' in their brief. *Id.* But, as the petition explains, *see* Pet. 17 n.2, that holding is subsidiary to the broader question whether the CNG itself infringes respondents' copyrights, and is thus "fairly included" within the first question presented, *see* S. Ct. Rule 14.1(a); *Lebron v. National R.R. Passenger Corp.*, 513 U.S. 374, 379-80 (1995).

accusation on the merits. Rather, they assert that the accusation is "dictum that in no way was relevant or essential to the court's holding of copyright infringement." Opp. 20; *see also id.* at 21 (characterizing accusation as "an aside that touches on a question that was not before the court."). That position is, to say the least, curious: if anything, the Eleventh Circuit's serious and manifestly erroneous accusation is *more*, not *less*, offensive to the extent it is gratuitous. And the Eleventh Circuit only added insult to injury by refusing even to consider the views of the Copyright Office on this issue of Copyright Office procedure. Indeed, this Court may wish to call for the Solicitor General to present the views of the United States in this case, so that the Copyright Office, the federal agency with statutory expertise and responsibility for the administration of the Copyright Act, will have an opportunity to be heard. *Cf. Tasini*, 121 S. Ct. at 2388 n.3, 2389 n.6 (relying on the views of the Register of Copyrights in construing Section 201(c)).

Although the issues in this case are worthy of plenary review, at the very least this Court should grant, vacate, and remand in light of *Tasini* (and, if appropriate, the views of the United States). Respondents' *amici* suggest that such a GVR is unnecessary because the publishers lost in both cases. Br. of *Amici Curiae* American Society of Media Photographers *et al.* 8-9. But there is no dispute that the Eleventh Circuit's reasoning is completely different from (and, petitioners submit, inconsistent with) *Tasini*'s reasoning. At the very least, this Court should afford the parties the opportunity to present the Eleventh Circuit with their very different interpretations of *Tasini* and its impact on this case.

CONCLUSION

For the foregoing reasons, and those set forth in the petition, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

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